



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/620,525 | 07/20/2000 | Bruce E. Novich | 1596C4 | 2888 |

7590

10/23/2002

MARK D. SWEET, ESQUIRE
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

EXAMINER

GRAY, JILL M

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

ASH

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/620,525 | Applicant(s) NOVICH ET AL. | |
| | Examiner Jill M Gray | Art Unit 1774 | |

-- **The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 9-12, 15-17 and 33-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, 13, 14 and 18-32 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, further electing the boron nitride particles of claims 13 and 14 in Paper No. 13 is acknowledged. The traversal is on the ground(s) that no serious burden exists for the examiner. This is not found persuasive because each of the particles have different functions and properties and thus can necessitate different searches. Claims 9-12, 15-17, and 33-63 are non-elected, wherein claims 33-43 were drawn to the mixed particle embodiment.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-8, 13-14, and 18-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Publication No. 208,268, translation, (hereinafter referred to as Sugano) in view of Japanese Patent Publication No. 5-110218, translation, (hereinafter referred to as Sasaki).

Sugano teaches a glass cloth impregnated with an aqueous coating composition containing inorganic particles, wherein said composition comprises a film-forming material and at least one lubricious material different from the particles, as required by claims 1-2, 4-5, 13 and 25. The particle size is within the range contemplated by

Art Unit: 1774

applicants in claim 19 and the film former is of the type set forth by applicants in claims 27-28. In addition, the particles, lubricious material and film-former are each present in amounts as claimed by applicants in claims 20, 23, and 29-30. Sugano does not teach the specific glass fibers used or boron nitride as the inorganic particles.

Sasaki teaches a laminate formed by impregnating a glass fiber substrate with a resin composition containing inorganic filler material. The substrate comprises glass fibers of the sort set forth by applicants in claim 6, and the inorganic filler material can be boron nitride.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a glass fiber cloth as taught by Sugano utilizing any glass fibers known and commercially available in the art, such as the glass fibers contemplated by applicants and as taught by Sasaki, with the reasonable expectation of success of using a known article in its known manner. In the absence of clear factual evidence to the contrary, this is not seen to be a matter of invention. Moreover, it would have been obvious to use as the filler of Sugano, boron nitride particles as taught by Sasaki to increase the lubricity of the glass fibers of Sugano thereby reducing fiber breakage.

Therefore, it is the examiner's position that the combined teachings of Sugano and Sasaki would have rendered obvious the invention as claimed in present claims 1-2, 4-8, 13-14, and 18-32.

Response to Arguments

Art Unit: 1774

4. Applicant's arguments with respect to claims 1-63 have been considered but are moot in view of the new ground(s) of rejection.

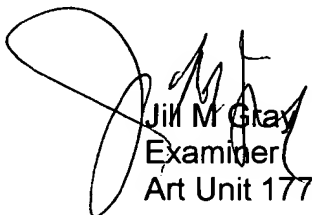
Allowable Subject Matter

5. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M Gray whose telephone number is 703.308.2381. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703.308.0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.5408 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0651.


Jill M Gray
Examiner
Art Unit 1774

jmg
October 21, 2002